

APPLICANTS: Soutar and McGrath
U.S.S.N.: 10/099,936

REMARKS

Amendments to the Claims

Claims 32-40 are added. Upon entry of the present amendments, claims 18-40 are pending. The present amendment does not introduce new matter.

New claims 32-40 cover substantially the same subject matter as published claims 9-12, 14, 15, 17, 18 and 19 in published U.S. Patent Application No. 20010016232 A1 (USSN 09/821,205; inventors: Redline *et al.*; published: August 23, 2001). This published patent application is a Division of U.S. 6,200,451 B1. A Request for a Declaration of Interference between the present application and U.S. 6,200,451 B1 was filed on March 13, 2002.

Under the interference provisions of 35 U.S.C. §135(b)(2), claims that are for the same or substantially the same subject matter as a claim of a published application may be made in an application filed after the application is published only if the claims are made before 1 year after the date on which the application is published. The present claims, which are for substantially the same subject matter as claims of USSN 09/821,205, are filed within one year of the August 23, 2001 publication date of USSN 09/821,205. Hence, filing of these claims complies with 35 U.S.C. §135(b)(2).

Of the new claims, claims 32 and 38 are in independent form. Applicants' claims 32 and 38 respectively differ from claims 9 and 17 of U.S. 20010016232 A1 in that the recited additives in the Markush groups of applicants' claims do not explicitly include amphoteric salts, resinous amines, resinous amides, fatty acids, or resinous acids.

The text of new claims 33-37, 39 and 40 is copied verbatim from claims in U.S. 20010016232 A1, as follows:

<u>Applicants' Claim</u>	<u>Claim in U.S. Patent 6,200,451</u>
33	10
34	11

APPLICANTS: Soutar and McGrath
U.S.S.N.: 10/099,936

35	12
36	14
37	15
39	18
40	19

Claims 13, 16 and 20 of U.S. 20010016232 A1 are directed to selected ingredients falling within the broader classes of additives recited in the independent claims. These particular embodiments are obvious in view of the broader classes. Accordingly, all of the new claims added herein and all of published claims in U.S. 20010016232 A1 are directed to the same invention.

The new claims and their counterparts in U.S. 20010016232 A1 are believed to correspond to proposed counts I and II, as set forth in the Request for a Declaration of Interference, filed with this application on March 13, 2002. Specifically, Applicants believe that new claims 32-37 of the present application and published claims 9-12, 14 and 15 of U.S. 20010016232 A1 correspond with proposed count I. Applicants further believe that new claims 38-40 and published claims 17-19 of U.S. 20010016232 A1 correspond with proposed count II.

In accordance with 37 C.F.R. 1.607(a)(5), the following tables show that new claims 32-40 are supported by the specification of the present application. The citations in the tables are exemplary only and not exclusive.

Text of Claim 32	Support in Specification of Present Application
A process for improving the solderability of a metal surface, said process comprising:	Page 14, lines 5-13; page 16, lines 24-26; page 19, lines 2-13; page 22, lines 8-15.
a). contacting the metal surface with an immersion silver plating solution thereby producing an immersion silver plate upon the metal surface;	Page 14, lines 5-13; page 15, lines 7-9 and 15-25.
and thereafter b). treating the immersion silver plated metal surface with a solution comprising an additive selected from the group consisting of fatty amines, fatty amides, quaternary salts, and ethoxylated versions of any of the foregoing,	Page 16, lines 24-26; Page 22, line 10 ("fatty acid amines"); Page 22, line 13 ("amides" listed as a type of fatty acid amine); Page 22, line 14; Page 22, lines 13-15.

Text of Claim 33	Support in Specification of Present Application
A process according to claim 32 wherein the silver plating solution also comprises material selected from the group consisting of imidazoles,	Page 16, lines 16-23; Page 23, line 4.
benzimidazoles,	Page 23, line 8.
imidazole derivatives and	Page 22, line 26; page 23, lines 6-7.
benzimidazole derivatives,	Page 23, lines 10-11; page 33, line 6.

Text of Claim 34	Support in Specification of Present Application
A process according to claim 32 wherein the silver plating solution also comprises an oxidant.	Page 20, line 23, through page 21, line 24 (complexing agents can act as oxidants).

Text of Claim 35	Support in Specification of Present Application
A process according to claim 32 wherein the metal surface comprises copper.	Page 27, lines 16-18; page 28, lines 6-9.

Text of Claim 36	Support in Specification of Present Application
A process according to claim 35 wherein the silver plating solution also comprises material selected from the group consisting of imidazoles,	Page 16, lines 16-23; Page 23, line 4.
benzimidazoles,	Page 23, line 8.
imidazole derivatives and	Page 22, line 26; page 23, lines 6-7.
benzimidazole derivatives,	Page 23, lines 10-11; page 33, line 6.

Text of Claim 37	Support in Specification of Present Application
A process according to claim 35 wherein the silver plating solution also comprises an oxidant.	Page 20, line 23, through page 21, line 24 (complexing agents can act as oxidants).

Text of Claim 38	Support in Specification of Present Application
<p>An immersion silver plating solution comprising an additive selected from the group consisting of</p> <p>fatty amines,</p> <p>fatty amides,</p> <p>quaternary salts, and</p> <p>ethoxylated versions of any of the foregoing.</p>	<p>Page 14, lines 6-13; page 16, lines 16-19;</p> <p>Page 22, line 10 (“fatty acid amines”);</p> <p>Page 22, line 13 (“amides” listed as a type of fatty acid amine);</p> <p>Page 22, line 14;</p> <p>Page 22, lines 13-15.</p>

Text of Claim 39	Support in Specification of Present Application
<p>An immersion plating solution according to claim 38 also comprising a material selected from the group consisting of</p> <p>imidazoles,</p>	<p>Page 16, lines 16-23;</p> <p>Page 23, line 4.</p>
<p>benzimidazoles,</p>	<p>Page 23, line 8.</p>
<p>imidazole derivatives and</p>	<p>Page 22, line 26; page 23, lines 6-7.</p>
<p>benzimidazole derivatives,</p>	<p>Page 23, lines 10-11; page 33, line 6.</p>

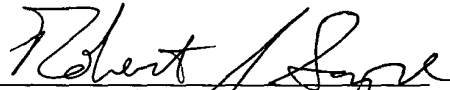
Text of Claim 40	Support in Specification of Present Application
<p>An immersion plating solution according to claim 38 also comprising an oxidant.</p>	<p>Page 20, line 23, through page 21, line 24 (complexing agents can act as oxidants).</p>

APPLICANTS: Soutar and McGrath
U.S.S.N.: 10/099,936

CONCLUSION

Applicants respectfully request that the above amendments be entered and that favorable review be granted thereto. Applicants further request that an interference be declared between the present application and both U.S. Patent 6,200,451 (for the reasons submitted in the Preliminary Amendment and Request for a Declaration of Interference filed on March 13, 2002) and USSN 09/821,205 (U.S. 20010016232 A1). If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



A. Jason Mirabito, Reg. No. 28,161
Robert J. Sayre, Reg. No. 42,124
Attorney for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

Dated: August 1, 2002